

Claims 1-16 are pending in this application which should be reviewed for errors. In response to the restriction requirement, applicants elected group II with traverse. In response to applicants' arguments the groups have been rejoined. Upon the further request for the election of a single disclosed species, applicants elected the compound of claim 19. Applicants' compounds substituted by H or alkyl on the amino nitrogen and which are 3,5- alkyl compounds without further substitution are examined therewith with all other compounds held withdrawn.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7, 9, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Burckhalter et al. who disclose 2[(diethylamino)methyl]-3,5-dimethyl-phenol as an antimalarial agent.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Cragoe, Jr. et al., US 3,794,734, who disclose 2-(aminomethyl)-3,5-bis(1,1-dimethylethyl)-phenol hydrochloride and by Stokker et al. who additionally disclose 2-(aminomethyl)-3,5-dimethyl-phenol hydrochloride.

Claims 1, 3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by and Finn et al. who disclose 2-[(dimethylamino)methyl]-3,5-dimethyl-phenol.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burckhalter et al. who disclose compounds of the formula at the top of the right column of page 1894 as antimalarials and who disclose the anticipating compound noted above. R1 may be H or alkyl, R2 may be alkyl, and R may be hydrogen or alkyl. The instant invention differs from the teaching of Burckhalter et al. in that although further compounds are disclosed generically, not all of applicants' compounds are specifically exemplified. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of Burckhalter, and especially in view of the anticipating compound noted above, to make applicants' compounds and expect them to be useful as antimalarials..

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teaching of Cragoe, Jr. et al., US 3,794,734, and Stokker et al. Cragoe et al.

Art Unit: 1621

disclose compounds of formula I wherein X1 and X3 may be alkyl as diuretics and saluretics and disclose the anticipating compound noted above. Stokker et al. is relied on to disclose further anticipating compounds of the same utility. The instant invention differs from the teaching of Cragoe, Jr. et al. and Stokker et al. in that although further compounds are disclosed generically, not all of applicants' compounds are specifically exemplified. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of the cited references and especially in view of the anticipating compound noted above, to make applicants' compounds and expect them to be useful as diuretics and saluretics.

No claim is allowed.

Any inquiry concerning this communication should be directed to Peter G. O'Sullivan at telephone number (571)272-0642.

/Peter G O'Sullivan/

Primary Examiner, Art Unit 1621